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| APPLICATION NO.          | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------|-------------|----------------------|---------------------|------------------|
| 09/717,906               | 11/20/2000  | Seth A. Yellin       | 07043.0001 U3       | 1867             |
| 23859                    | 7590        | 07/16/2004           | EXAMINER            |                  |
| NEEDLE & ROSENBERG, P.C. |             |                      | KOPPIKAR, VIVEK D   |                  |
| SUITE 1000               |             |                      | ART UNIT            |                  |
| 999 PEACHTREE STREET     |             |                      | PAPER NUMBER        |                  |
| ATLANTA, GA 30309-3915   |             |                      | 3626                |                  |

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/717,906

**Applicant(s)**

YELLIN ET AL.

**Examiner**

Vivek D Koppikar

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/20/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Status of Application***

1. This communication is in response to the application filed on November 20, 2000. This application claims priority to provisional application No. 60/189,527 filed on March 15, 2000. The Information Disclosure Statement (IDS) filed by the applicants on October 8, 2002 has been acknowledged by the examiner. Claims 1-42 are pending in this application and have been examined.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 10-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,832,450 to Myers in view of US Patent Number 6,268,788 to Gray and in further view of US Patent Application Publication 2001/0027439 to Holtzmann.

Myers is directed towards an electronic medical record using text database. Gray is directed towards an apparatus and method for providing an authentication system based on biometrics. Holtzmann is directed towards a method and system for computerized form completion.

As per claim 1, which is directed towards a system for managing a person's healthcare information, Myers teaches a database system for healthcare information relating to a plurality of patients. The database has an interface to a wide-area network (WAN). A plurality of base

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units remotely located from the database system associable with a healthcare provider communicate with the database (Figure 1, Col. 3, Ln. 58-Col. 4, Ln. 16).

Myers fails to teach the use of a unique identifier which is the only means to identify the record and the use of biometric tokens which enables data to be accessed through the base units. However these features are well known in the art as evidenced by Gray and Holtzmann. Holtzman teaches coding data or a computer program with a unique identifier (identified only by an identifier code and not by name or other biographic information) (Sections [0012]-[0013] and [0037]). At the time of the invention, one of ordinary skill in the art would have been motivated to code the data in the database of Myers with these unique identifiers as taught in Holtzman in order to provide a secure system of processing on-line information requests as recited in Holtzmann (Section [0012]).

Gray teaches a plurality of patient tokens, each token associable with an individual patient and portable by the patient and having a memory in which are storable biographical information identifying the patient and an identifier code corresponding to the identifier code in the database system relating to a corresponding entry for the individual patient in a computer program (database system) (Figure 4, Col. 4, Ln. 5-28 and Col. 14, Ln. 3-16). The apparatus taught by Gray further includes a token interface circuit and has a biometric processor with a sensor. Access to the computer program is allowed only when a verification device (biometric processor) verifies the patient's identify by determining that the patient has a biometric predetermined to be uniquely identifiable with the patient (and not with other patients). The token is placed in proximity with the token interface circuit (Col. 13, Ln. 26-45 and Figures 8 and 10—(25) and (27)). Once the token is verified using the biometric processor, data can be

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either input (into the database or computer program) or input into the computer program or database (Col. 13, Ln. 37-39). At the time of the invention, one of ordinary skill in the art would have been motivated to add a system of biometric tokens to provide access to the data in the database in order to provide a simple and cost-effective system to control access to data as recited in Gray (Col. 3, Ln. 14-17).

As per claim 2, in Gray the information stored in the memory of the token is in encrypted format (Col. 6, Ln. 1-8).

As per claim 3, in Gray the biometric processor is a fingerprint analyzer, and its sensor is a fingerprint scanner (Col. 14, Ln. 3-16).

As per claim 4, in Gray the token has a card-like shape (Col. 14, Ln. 49-54).

As per claim 5, in one embodiment of Gray the token is a smart card having a processor (Col. 18, Ln. 49-67).

As per claim 6, in Myers the base unit (e.g. computers or health care providers) has a computer interface through which information can be communicated between the base unit and a computer operated by a healthcare provider (Figure 1 and Col. 4, Ln. 4-16).

As per claim 7, in Myers the users using the provider workstations (Figure 1) have the capability to read information from the database and write information to the database (bi-directional communication) (Col. 3, Ln. 39-45).

As per claim 10, in Myers data can be accessed wirelessly over a wide area network (Col. 3, Ln. 55-57).

As per claim 11, the base unit in Myers (the computers of the providers) includes a display on which healthcare information is displayable (Figure 1-Provider Workstations).

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As per claim 13, in Myers a user can read data over a wide area network (Col. 3, Ln. 66-Col. 4, Ln. 3). In the combined system of Myers in view of Gray and Holtzmann the data from the database of Myers is readable in response to a secure personal identification number (biometric token) received from a remote computer.

As per claim 14, in Gray vital individual patient information is stored in the memory of each token (Col. 14, Ln. 3-8).

As per claim 15, in Myers the base unit includes a display on which vital medical information is displayable (Figures 1 and 3).

As per claims 16 and 17, in Gray vital information (insurance and prescription) is stored in the biometric token (Col. 14, Ln. 3-8).

4. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers in view of Gray and Holtzman, as being applied to Claim 6 above, and in further view of Minoz.

Neither Myers, Gray nor Holtzman teach the concept allowing a user to read information only during a predetermined time interval and necessitating that the user re-enters the password (or biometric token) if they desire the read information and the time interval has lapsed. The feature is known as "time out" and is well known in the art as evidenced by Minoz (Col. 5, Ln. 18-45). At the time of the invention, one of ordinary skill in the art would have been motivated to add this time out feature to the healthcare information management system of Myers in view of Gray and Holtzman in order to ensure that unauthorized users would not gain access to sensitive data.

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5. Claim 12 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Myers in view of Gray and Holtzman, as being applied to Claim 1, and in further view of "Diebold & Keyware Technologies heighten security" hereafter referred to as Diebold.

Neither Myers, Gray nor Holtzmann teach the feature of providing voice input or verbal instructions. However these features are well known in the art as evidenced by Diebold which teaches a medicine dispensing unit accessed by biometric means (Paragraph 2). At the time of the invention one of ordinary skill in the art would have been motivated to add this voice recognition and verbal instruction feature to the healthcare information management system of Myers in view of Gray and Holtzmann in order to provide an additional layer of security as recited in Diebold (Paragraph 2).

6. Claims 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,832,450 to Myers in view of US Patent Number 6,268,788 to Gray.

As per claim 18, which is directed towards a system of managing healthcare patient information storable in a database and accessible by tokens associated with patients, Myers teaches a database system for healthcare information relating to a plurality of patients. The database has an interface to a wide-area network (WAN). A plurality of base units remotely located from the database system associable with a healthcare provider communicate with the database (Figure 1, Col. 3, Ln. 58-Col. 4, Ln. 16). The users using the provider workstations (Figure 1) in Myers have the capability to read information from the database and write information to the database (bi-directional communication) (Col. 3, Ln. 39-45).

Gray teaches a plurality of patient tokens, each token associable with an individual patient and portable by the patient and having a memory in which are storable biographical

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information identifying the patient and an identifier code corresponding to the identifier code in the database system relating to a corresponding entry for the individual patient in a computer program (database system) (Figure 4, Col. 4, Ln. 5-28 and Col. 14, Ln. 3-16). The apparatus taught by Gray further includes a token interface circuit and has a biometric processor with a sensor. Access to the computer program is allowed only when a verification device (biometric processor) verifies the patient's identify by determining that the patient has a biometric predetermined to be uniquely identifiable with the patient (and not with other patients). The token is placed in proximity with the token interface circuit (Col. 13, Ln. 26-45 and Figures 8 and 10—(25) and (27)). Once the token is verified using the biometric processor, data can be either input (into the database or computer program) or input into the computer program or database (Col. 13, Ln. 37-39). At the time of the invention, one of ordinary skill in the art would have been motivated to add a system of biometric tokens to provide access to the data in the database in order to provide a simple and cost-effective system to control access to data as recited in Gray (Col. 3, Ln. 14-17).

As per claims 19-26, in Myers a user using the provider workstation (Figure 1) can view charts in a graphic format. Users are also enabled to enter data related to diagnosis, treatment, test results, prescriptions and pharmacy information (Figure 1, 2a, 2b, 2c, Col. 3, Ln. 58-Col. 5, Ln. 2).

7. Claim 27-31, 34-35 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,832,450 to Myers in view of US Patent Number 6,268,788 to Gray and in further view of US Patent Application Publication 2001/0027439 to Holtzmann.



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Claim 27 is similar in all respects to claim 1 except that it is directed towards a method for managing healthcare patient information rather than a system for managing healthcare patient information. Therefore, the limitations recited in the body of claim 27 are addressed in the same section, above, where claim 1 is addressed.

As per claim 28, in Gray biometric data is stored in a token (Col. 14, Ln. 3-8).

As per claims 29-30, the examiner takes official notice with regard to the concept of issuing a replaceable token. At the time of the invention, one skilled in the art would have been motivated to issue another token to a patient so that the patient could continue using the healthcare information system. Further, since the knowledge and use of replaceable tokens, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995). The biometric data is stored in a remote database (Figure 2 and Col. 14, Ln. 3-8).

As per claim 31, in Myers the base unit includes a display on which vital medical information is displayable (Figures 1 and 3). Healthcare information can be read from the system and written into the system from the base providers after the identify of the user has been identified in the system of Myers in view of Gray and Holtzmann (Myers, Col. 3, Ln. 39-45).

As per claim 34, in Gray the information stored in the memory of the token is in encrypted format (Col. 6, Ln. 1-8).

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As per claim 35, in Myers data can be accessed wirelessly over a wide area network (Col. 3, Ln. 55-57).

As per claim 37, in Myers a user can read data over a wide area network (Col. 3, Ln. 66-Col. 4, Ln. 3). In the combined system of Myers in view of Gray and Holtzmann the data from the database of Myers is readable in response to a secure personal identification number (biometric token) received from a remote computer.

As per claims 38-42, in Myers a user using the provider workstation (Figure 1) can view charts in a graphic format. Users are also enabled to enter data related to diagnosis, treatment, test results, prescriptions and pharmacy information (Figure 1, 2a, 2b, 2c, Col. 3, Ln. 58-Col. 5, Ln. 2).

8. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers in view of Gray and Holtzman, as being applied to Claim 31 above, and in further view of Minoz.

Neither Myers, Gray nor Holtzman teach the concept allowing a user to read information only during a predetermined time interval and necessitating that the user re-enters the password (or biometric token) if they desire the read information and the time interval has lapsed. The feature is known as "time out" and is well known in the art as evidenced by Minoz (Col. 5, Ln. 18-45). At the time of the invention, one of ordinary skill in the art would have been motivated to add this time out feature to the healthcare information management system of Myers in view of Gray and Holtzman in order to ensure that unauthorized users would not gain access to sensitive data.

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9. Claim 36 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Myers in view of Gray and Holtzman, as applied to Claim 27, and in further view of "Diebold & Keyware Technologies heighten security" hereafter referred to as Diebold.

Neither Myers, Gray nor Holtzmann teach the feature of providing voice input or verbal instructions. However these features are well known in the art as evidenced by Diebold which teaches a medicine-dispensing unit accessed by biometric means (Paragraph 2). At the time of the invention one of ordinary skill in the art would have been motivated to add this voice recognition and verbal instruction feature to the healthcare information management system of Myers in view of Gray and Holtzmann in order to provide an additional layer of security as recited in Diebold (Paragraph 2).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Vivek Koppikar** whose telephone number is **(703) 305-5356**. The examiner can normally be reached on Monday-Friday from 8 AM to 5 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9306.

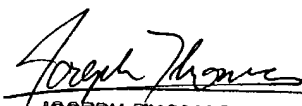
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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*VK*

Vivek Koppikar

6/30/04

  
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